

**REMARKS – General**

1. Re Examiner's response [1], Applicant duly notes response.
2. Re Examiner's response [2], Applicant duly notes response.
3. Re Examiner's response [3], Applicant has amended Claims 14(g), 14(h), 36(g) and 36(h) to overcome the Rejection under 35 USC § 112.
4. Re Examiner's response [4], Applicant has amended Claims 14 and 36 to overcome the Rejection under 35 USC § 112.
5. Re Examiner's response [5], Applicant respectfully requests that the Examiner reconsiders the objection to Applicant's use of the term '**Bluetooth**' in Claims 16 and 38. Applicant's respectful request is based on the following US Patent Office precedence:

As of Applicant's online search dated March 24, 2008 of the US PTO's Issued Patents database (PatFT) using the search term '**Bluetooth**' in issued patents (i.e. ACLM/bluetooth), the PatFT system returned one thousand, one hundred and seventy-five (1,175) patents. The earliest US issued patent to use the term '**Bluetooth**' in its claims is Madsen, et al. patent number 6,181,284, issued January 30, 2001. The most recent issued patent to use the term '**Bluetooth**' in its claims is Hullot, et al. patent number 7,346,705, issued March 18, 2008.

It is commonly known in the art that a '**Bluetooth**' network that communicates between two pertinent devices provides more than a "**Short range radio frequency link**". A '**Bluetooth**' communications network includes providing:

- (a) a physical radio channel which is shared by a group of devices that are synchronized to a common clock and frequency-hopping pattern, (b) a piconet

consisting of Master and Slave Devices, in which one device provides the synchronization reference and is known as the master. All other devices are known as slaves. A group of devices synchronized in this fashion form a piconet. This is the fundamental form of communication for Bluetooth wireless technology. Devices in a piconet use a specific frequency-hopping pattern that is algorithmically determined by certain fields in the Bluetooth specification address and clock of the master. The basic hopping pattern is a pseudo-random ordering of the 79 frequencies in the ISM band. The hopping pattern may be adapted to exclude a portion of the frequencies that are used by interfering devices. The adaptive hopping technique improves Bluetooth technology co-existence with static (non-hopping) ISM systems when these are co-located. Piconets are established dynamically and automatically as Bluetooth enabled devices enter and leave radio proximity. A fundamental Bluetooth wireless technology strength is the ability to simultaneously handle both data and voice transmissions. [source: Bluetooth Special Interest Group (SIG)].

In consideration of the above US Patent Office precedence in using the term '**Bluetooth**' in over 1,100 US Issued Patents' claims, and the commonly known art that a '**Bluetooth**' network is much more than a "**Short range radio frequency link**", Applicant respectfully requests that the Examiner allows the term '**Bluetooth**' in Claims 16 and 38 to overcome the Rejection under MPEP § 608.01(v).

### **Re Examiner's Response To Arguments**

6. Re Examiner's response [6], Applicant duly notes response.
7. Re Examiner's response [7], Applicant respectfully requests that the Examiner reconsiders Rejections under 35 USC § 103 of Claims 14-15, 17-19, 34-37, 39-41 and 43-44 as being un-patentable over the cited prior art of Ruppert et al in view of Petrovich et al. Applicant has modified Claims 14 and 36 to

overcome this rejection. Furthermore Applicant has added new Claims 45-46  
62.

Neither Ruppert et al, nor Petrovich et al teach the *new and unexpected use* of date and time stamps of previously entered barcodes *to set up a predictive shopping list database of a consumer's commonly and frequently used / needed products*. This shopping list database is used not only to generate a list of bar-coded products that the consumer has currently entered into the system, e.g. on March 24, 2008 at 10:00, but is used as well in order to predict if and when the consumer will need to shop for a product which the consumer may not be aware of at the current moment (e.g. on March 24, 2008 at 10:00), i.e. when the consumer generates a new / current shopping list.

Applicant's claimed invention (specifically in Claims 14(iv), 14(v), 14(vi), 36(iv), 36(v) and 36(vi)) will ascertain whether or not previously entered bar-coded products (e.g. March 1, 2008 at 08:00, March 14, 2008 at 17:00 and March 17, 2008 at 20:00), should also be placed on the consumer's current shopping list (e.g. March 24, 2008 at 10:00) *even though the consumer has not entered the products' barcodes on his current shopping list*. In other words, Applicant's invention *learns over time the consumption habits of the consumer* by building a database of previously entered shopping lists, by including the date and time on which the consumer entered each product. This *new and unexpected use* of the date and time on which a product was previously entered into a shopping list is critical to the invention's non-obvious use of a predictive shopping list database to aid a consumer. *Consequently Applicant's invention can automatically add items to the consumer's current shopping list, even though the consumer may be unaware that he needs the item(s), which the invention automatically adds to his current shopping list.*

7.1) The Examiner's citation of Ruppert et al "**(see col. 8 lines 50-53)**" in reference to Applicant's Claims 14(iv) and 36(iv) clearly does not "track frequency" of any data entered into the portable barcode scanner, but cites "*or external modem (not shown) coupled to the microprocessor 40 through data communications interface and port 85 and downloading the store's current price*". Applicant's Claims 14(iv) and 36(iv) track the frequency (i.e. how often / the rate with which products have been entered into the system) with which barcodes have previously been entered into the invention. This is important in order to set up a predictive shopping list database, which will "know" when the consumer needs a product that he may not be aware of at the time of creating a new / current shopping list.

The cited references of Ruppert and Petrovich teach away from this non-obvious method that is taught in Applicant's invention, and at no time do the cited prior art "*suggest the desirability and thus the obviousness of making the combination*" (Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434 [C.A.F.C. 1988]) to track the frequency at which products are entered into the scanner.

7.2) The Examiner's citation of Petrovich "**(see Para [0105], [0097])**" in reference to Applicant's claimed means of printing a shopping list at home, before heading to a store teaches away from Applicant's invention. Petrovich Para [0105], considered in conjunction with Fig. 1 for clarity purposes, teaches: "*When the user instead wishes to travel to shopping establishment 14 to shop, **they can dock the portable terminal 40 in the kiosk cradle 24.** The appropriate shopping list in memory 46 is then downloaded and stored in the database in host computer 16. As noted in*

the discussion of the method, the user can print the hard copy of the order and check items off with an ink pen as they are scanned with portable terminal 40 and deposited in, for example, a shopping cart of the user". This described process, including the printing of the shopping list occurs *inside* a "*shopping establishment*", i.e. it requires that the consumer *enters* the "*shopping establishment*" to print the list. This printing functionality is not described in Petrovich to occur at the consumer's home (Fig. 1, item 10). Similarly, Petrovich Para [0097] teaches the requirement that the consumer must *enter* a "*shopping establishment*" in order to print the shopping list using the "*kiosk 24*". Petrovich teaches that the "*kiosk 24*" is *only* located in a "*shopping establishment*" (see including Fig. 1 and Fig. 6 and Para [0063]).

Petrovich's "*Home cradle 30*" is clearly not associated with a printer (see Para [0064 - 0068] and Fig 1). Further support of this *in-store only* printing of a shopping list by Petrovich can clearly be found in Paragraphs [0078], [0093] and [0107]. In these paragraphs Petrovich describes an *in-store* "*Printer 96*", which it is also clearly marked in Fig. 1 and Fig. 6.

It is obvious that the primary goal of Petrovich's invention is to get the consumer physically into the "*shopping establishment*", i.e. it teaches away from Applicant's invention, that teaches a shopping system and method that does not require the consumer to enter a store.

- 7.3) The Examiner's taking Official Notice that "**including the time and date when the barcode was scanned is well know and old in the art at the time the**

**invention was made**” is noted, but Applicant respectfully brings the Examiner’s attention to the fact that *how*, i.e. the manner in which the date and time stamp is *used* by Applicant’s invention is *new and unexpected* and therefore non-obvious in the art. Applicant has modified Claims 14 and 36 to further clarify this non-obvious *new and unexpected use* of an entered barcode’s date and time stamp.

Applicant teaches the non-obvious *new and unexpected use* of the entered barcode’s date and time stamp to create on the “consumer’s first computer” a predictive shopping list database of the consumer’s past consumption habits. This predictive shopping list database system is activated when the consumer creates a new shopping list (i.e. a current shopping list) in order to go shopping. This activation includes automatically placing, i.e. adding items to the current shopping list, without the consumer’s “current” intervention, because it “knows” products that the consumer has most probably run out of, or is soon to run out of and consequently most probably needs, but has neglected (i.e. has forgotten or is unaware of the current need) to enter the item(s) on the current shopping list.

In the advent that this clarification of Applicant’s invention’s non-obvious, *new and unexpected use* of the entered barcode’s date and time stamp is respectfully unsatisfactory in the Examiner’s continued taking Official Notice, Applicant respectfully challenges the Examiner’s **“Official Notice that the time and date of when the barcode was scanned is well known and old in the art at the time of invention”** and respectfully requests evidence to support this claim (see 37 C.F.R. 1.104(c)(2), 37 C.F.R. 1.104(d)(2) and Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697).

7.4) The Examiner’s citation of Ruppert et al “(see col. 6 lines 1-10)” in reference to Applicant’s Claim 17 does not teach connecting a

scanner to a "consumer's first computer". The reference cited by the Examiner teaches connecting Ruppert's scanner wherein a shopping "*price list is downloaded by the handheld scanner upon entry to the store. This can be done by direct connection to the store's computer via an RS232 port shown symbolically at 40 in FIG. 1*" [col. 6, lines 1-5]. Clearly Ruppert's "**store computer**" is not a "consumer's first computer" as claimed in Applicant's Claim 17. Ruppert teaches away from using a "consumer's first computer" as is taught by Applicant's invention.

7.5) The Examiner's citation of Ruppert et al "**(see col. 6 lines 1-5)**" in reference to Applicant's Claim 18 does not teach using a wired link incorporating USB nor IEEE 1394. This cited reference clearly only teaches using a wired RS232 link.

7.6) The Examiner's citation of Ruppert et al "**(see col. 6 lines 1-5 and fig. 1)**" in reference to Applicant's Claim 19 does not teach (a) using a "consumer's first computer" and (b) that the computer is from a list comprising "a personal computer, a personal digital assistant, an Internet appliance, and a cell phone" as is taught in Applicant's Claim 19. The cited reference teaches connecting Ruppert's scanner to a "store's computer" [col. 6 line 4] "upon entry to the store" [col. 6 line 3].

Applicant respectfully queries the Examiner's citation of Ruppert's Fig. 1 as evidence of using "consumer's first computer", other than the cited diagram has a "DOWNLOAD 42" button. This button 42 is used by Ruppert such that "*the user enters the store, he or*

*she downloads the price list by touching the **download button 42** on the screen with the light pen or a physical button (not shown) located elsewhere. The Personal Scanner.TM. device then downloads the store's current price list using the infrared transceiver or the RS232 port"* [**col. 6 lines 11-14**]. Clearly Ruppert teaches away from using a "consumer's first computer", as is taught by Applicant's invention.

7.7) The Examiner's citation of Ruppert et al "**(see col. 6 lines 1-5)**" in reference to Applicant's Claim 34 does not teach that a "portable computer device is selected from the group consisting: a personal digital assistant and a cell phone". Ruppert's Personal Scanner <sup>TM</sup> is a portable device dedicated *solely* to the function of creating and managing shopping lists. Both a personal digital assistant and a cell phone are well known and old in the art to implement many other functions, other than solely the function of creating and managing shopping lists. Consequently, Applicant respectfully claims that Ruppert teaches away from Applicant's Claim 34.

7.8) Addressing the Examiner's claim rejection that it "**would have been obvious to one of ordinary skill in the art at the time of invention was made to employ a personal computer as an intermediary with the invention of Ruppert et al to store information so that less memory is used in the personal digital assistant**", Applicant's respectful response is as follows:

- i. Ruppert's scanner is not a "**personal digital assistant**", nor is there any suggestion in Ruppert that it could be (*Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 5 U.S.P.Q..2d 1434 [C.A.F.C. 1988]).



Ruppert's scanner is a "*Personal Scanner* <sup>TM</sup>", whose sole function is "*for aiding shoppers in keeping track of their expenditures and speeding the process of check-out and taking advantage of coupons*" [Abstract, lines 1-3]. It is well known and old in the art that a "**personal digital assistant**" has a lot more functionality than that which is described in Ruppert's dedicated "*Personal Scanner* <sup>TM</sup>".

- ii. The "consumer's first computer", e.g. a "**personal computer**" as claimed by the Applicant's invention teaches much more than simply "**to store information so that less memory is used in**" Ruppert's "*Personal Scanner* <sup>TM</sup>". In summary, the invention's "consumer's first computer" teaches (a) the creation and managing of a predictive shopping list database which timely alerts the consumer of items missing on a current shopping list, (b) communication with a repository for obtaining further detailed barcode information in order to supplement an entered barcode number, (c) optionally sending the shopping list to an online store and (d) printing a hardcopy of the current shopping list for the consumer. Furthermore it is well known and old in the art that much more OpenSource (i.e. free), quality software is available to implement a complex system on a "**personal computer**", than is available for a dedicated device such as Ruppert's "*Personal Scanner* <sup>TM</sup>".

7.9) With respect to Applicant's responses above, namely [7.4] – [7.7], Applicant's cited claims are part of a larger method / system which should be viewed "as a whole" (*Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 [1966]), rather than piecemeal. When viewed "as a whole", Applicant

respectfully submits that the invention is non-obvious and hence patentable over Ruppert in view of Petrovich under 35 USC § 103.

### **Re Examiner's Response To Arguments**

- 8) The Examiner's response [A] that Applicant "**failed to specially point out the supposed errors in the examiner's action**" with respect to the Examiner's taking Official Notice of the date and time stamp use has been addressed in part in Applicant's Remarks [7.3] above. Applicant shall endeavor to further traverse the Examiner's position in light of the requirements of 2144.03(c) as follows:

- 8.1) As stated in [7.3] above, Applicant's invention's teaching of the *new and unexpected use* of the entered barcodes' date and time stamps *in order to build a predictive shopping list database of the consumer's past consumption habits*, over a period of time, is non-obvious in the art.

In order further to traverse this argument, Applicant considers both of the sets of "References Cited" in, and "Referenced By" Ruppert et al. that use the terms (a) "**bar code**" or "**barcode**" and (b) "**timestamp**" or "**time stamp**" in each of the appropriate references' Specifications in order to determine whether or not Applicant's specific use of the date and time stamp of an entered barcode is "**well known and old in the art at the time of invention**".

- 8.1.1.) The only "References Cited" in Ruppert et al which include the above mentioned relevant terms (a) and (b) under consideration is Gutman et al patent number 5,221,838 (Gutman '838). Gutman '838 teaches "*a time stamp may be stored into memory 206*

*along with the received and recovered message information*" [col. 7, lines 10-11], and hence "*time information may be included with the message that is transmitted to the selective call receiver 200*" [col. 11, lines 32-34].

At no point is it taught, nor suggested in Gutman '838, nor in any of the other five (5) "References Cited" in Ruppert et al, Applicant's non-obvious *new and unexpected use* of the entered barcode's date and time stamp *to create an active predictive shopping list database system on the consumer's computer*, which assists the consumer to shop for items that he has neglected to add to his current shopping list.

Gutman '838 teaches away from Applicant's *new and unexpected use* of an entered barcode's date and time stamp. Furthermore, the majority of the "References Cited" in Ruppert do not even mention capturing an entered barcode's date and time stamp, and hence do not teach either the non-obvious *new and unexpected use* of the date and time stamp in order to create a predictive shopping list database as is taught by Applicant's invention, nor **"that the time and date of when the barcode was scanned is well known and old in the art at the time of invention"** as claimed by the Examiner's Official Notice under consideration.

8.1.2.) As of March 24, 2008 two hundred and sixteen (216) patents were "Referenced By" Ruppert et al. Applicant

narrowed this list down to those applications that include the above-mentioned relevant terms (a) and (b) under consideration. Applicant used the PatFT Query "REF/5424524 AND SPEC/(timestamp OR "timestamp") AND SPEC/(barcode OR "barcode")". This search returned only one (1) patent, i.e. Nulph patent number 7,247,095 (Nulph '095). Firstly, Nulph '095 was filed on October 8, 2004, i.e. after Applicant's filing date of February 13, 2001 and hence cannot be considered as prior art over Applicant's invention under 35 USC §102. Secondly, Nulph '095 teaches a "*Method and system for marketing and game selection for lottery products*" in which the date and time stamp of a gambling transaction is recorded. The "timestamp" term is mentioned twice (2) in Nulph '095, i.e. (1) "*information printed in relation to the specific lottery transaction of the player may include a date/timestamp 36 of the transaction*" [col. 10, lines 62-64] and (2) the "*date/timestamp 36 indicates that the play card 30 was printed on "Jul. 6, 2005 at 5:35 PM"*" [col. 11, lines 6-7]. Nulph '095 clearly teaches away from creating a predictive database of shopping lists as is taught by Applicant's invention. Furthermore, the majority of the "Referenced By" Ruppert do not even mention capturing an entered barcode's date and time stamp, and hence do not teach either the non-obvious *new and unexpected use* of the date and time stamp in order to create a predictive shopping list database as is taught by Applicant's invention, nor **"that the time and date of**

**when the barcode was scanned is well known and old in the art at the time of invention”** as respectfully claimed by the Examiner’s Official Notice under consideration.

- 8.2) In conclusion Applicant respectfully submits that the Examiner’s taking Official Notice that **“including the time and date when the barcode was scanned is well known and old in the art at the time the invention was made”** is not **“well known and old in the art”**, which Applicant has dutifully traversed in the above mentioned and pertinent applications. Specifically, Applicant respectfully submits that in context of Applicant’s *new and unexpected use* of an entered barcode’s date and time stamp *to create a predictive shopping list database system*, that *new and unexpected use* of an entered barcode’s date and time stamp is neither **“well known”** nor **“old in the art”**.

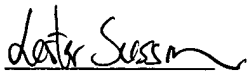
Using the guidance gratefully provided by the Examiner in the Office Action dated 02/11/2008 to institute a proper traversal pointing out the errors in the Examiner’s Action, Applicant respectfully requests the Examiner, according to MPEP 2144.03(c), to **“provide documentary evidence in the next Office action if the rejection is to be maintained”**. Alternatively Applicant respectfully requests that the invention as claimed should be considered non-obvious, making Applicant’s Claims patentable under 35 USC § 103.

- 9) Applicant submits that the above-recited novel features in Applicant’s independent Claims, and hence in all Claims, provides new and unexpected results and hence should be considered non-obvious, making the Claims patentable under 35 USC § 103.

### **Conclusion**

For all of the above reasons, Applicant respectfully submits that the specification and claims are now in proper form, and that the claims all define patentability over the prior art. Therefore Applicant submits that this application is now in condition for allowance, which action is respectfully solicited.

Very Respectfully,

A handwritten signature in cursive script, appearing to read "Lester Sussman", written over a horizontal line.

Lester Sussman

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